

Remarks

In claim 17, the term “pharmaceutically acceptable” has replaced “addition” in view of the rejection under 35 USC §112, first paragraph. Support for this amendment can be found throughout the specification at, for example, page 9, line 35. In addition, the second instance of piperidinylC₁₋₆alkylaminocarbonyl in R^{8,10,11} was deleted. It is submitted that no new matter has been added by the above amendments.

Objection to the Claims

Claim 17 was objected to for containing two recitations of piperidinylC₁₋₆alkylaminocarbonyl in R^{8,10,11}. (Office Action at page 4.) As noted above, claim 17 was have been amended to remove the second recitation of piperidinylC₁₋₆alkylaminocarbonyl in R^{8,10,11} and, it is submitted, the objection is rendered moot and should be withdrawn.

Claim 20 was objected to for its written text; the claim was amended to reads “A compound selected from”; and is followed by the claimed chemical structures. Additionally, said text compound 16, 144, and 145 was removed from under the claimed structures to clearly depict the subject matter being claimed.

Enablement Rejection

Claims 17-19, and 21 stands rejected under 35 USC §112, first paragraph, as failing to comply with the enablement requirement. (Office Action at page 4.)

Claims 17-19 and 21 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “pharmaceutically acceptable salts” and “stereo-chemically isomeric forms thereof” of the instantly claimed compounds, does not reasonably provide enablement for N-oxides and all addition salts of said compounds. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

(Office Action at page 4.)

For the reasons set forth below, the rejection is respectfully traversed.

While the conclusion that the rejected claims are not fully enabled is respectfully disagreed with, claim 17 has been amended in view of the admission in the Office Action

that “pharmaceutically acceptable” salts are enabled. With this amendment it is believed that claim 17 and the claims that depend therefrom are fully enabled and the instant rejection has been overcome. Therefore, the instant rejection should be withdrawn.

Obviousness-type Double Patenting

Claims 17-21 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-4, 6, 12, 14-16, and 26-30 of co-pending application number 10/595,882. (Office Action at page 3.).

While not agreed with, a terminal disclaimer is submitted concurrently herewith. With this submission it is believed that the instant rejection has been overcome and should be withdrawn.

Claims 17-21 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over co-pending application number 10/596086 “for the reasons of record.” (Office Action at page 3.).

With all due respect, claims 17-21 were not previously subject to this ground of rejection. In fact, a previous paper in the Application rejected claims 1-4, 7, and 13 over 10/596086. Those claims were cancelled and the instant rejection was not made until the Office Action was issued. It is believed that this ground of rejection is improper and should be withdrawn.

Finally, the Examiner is invited to call the applicants' undersigned representative if any further action will expedite the prosecution of the application or if the Examiner has any suggestions or questions concerning the application or the present Response. In fact, if the claims of the application are not believed to be in full condition for allowance, for any reason, the applicants respectfully request the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP § 707.07(j) or in making constructive suggestions pursuant to MPEP § 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,

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